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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/799,400	02/12/97	SASAKI	D KAMMON-3.0-0

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PM32/0323

EXAMINER

LEV, B

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 03/23/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/799,400**

Applicant(s)  
**Sasaki et al**

Examiner  
**Bruce A. Lev**

Group Art Unit  
**3634**



☒ Responsive to communication(s) filed on February 23, 1999 as a CPA

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-33 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-33 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 2, 5, 6, 7, and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "said end plate", i.e., in claim 2, line 2, is vague and indefinite since it is unclear which of the end plates is being referred to.

### ***Claim Rejections - 35 USC § 103***

2. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent of Sasaki et al 8,242,526 in view of Nimiya et al 4,933,512.

As concerns claims 1-28, and 31-33, Sasaki et al discloses the invention including a closure comprising a pair of semicylindrical sleeve members 1 vertically separable surrounding a cable connection section, wherein each has an abutting joint surface on the sides through which the sleeve members are joined; end plates 3 on opposite ends of the sleeve, each formed of rubber plastic material and having a cable guide hole 20, wherein said end plate is removably fitted with an opening prevention connection member 23 extending over both sides of the slit and removably fitted with a second rigidity holding member at a central portion between the guide holes and abutted against an end wall of the sleeve; hinges and fasteners, inclusive of members 27,28,30,34,

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releasably hooked between and connecting the sleeve members; end plates formed with slits, inclusive of 22,25, extending from the guide holes to an outer periphery of the end plate; and guide hole caps 21 with rigidity holding members viewed as the surfaces between the cap and the holes. **What Sasaki et al do not show** is a gasket including an adhesive between the end plates and the sleeves. However, **Nimiya et al show** gasket 60 including an adhesive, discussed in column 7 lines 15-20 and illustrated in figures 6a, 6b, and 7, between the end plates 40 and the sleeves 20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the closure of Sasaki et al by incorporating a gasket including an adhesive between the end plates and the sleeves, as taught by Nimiya et al, in order to increase the sealing capabilities between the plates and the sleeves, and to provide a secondary sealing means between the plates and the sleeves in case the inherent sealing capabilities of the plate fail.

As concerns claims 29,30 Sasaki et al 8,242,526 in view of Nimiya et al disclose the invention as claimed except for the gasket being made of thermoplastic rubber exhibiting a penetration, elongation, and tensile stress claimed. However, the examiner takes the position that since no engineering advantages have been disclosed for forming the gasket from these exact dimensions, and since it appears that various other dimensions would work equally as well, it would have been an obvious matter of engineering design choice, as determined through routine experimentation and optimization, to provide Sasaki et al with the values specified.

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***Response to Amendment***

3. Applicants' remarks filed February 23, 1999 have been fully considered but are not deemed to be persuasive.

As concerns the amendment to claim 1 (as per amendment A of April 17, 1998) which includes changing the phrase "an adhesive tape-like gasket" to --a gasket including an adhesive--, the examiner points out that the specification must reflect this terminology (i.e. page 14, line 37).

As concerns remarks pertaining to the configuration of Sasaki et al in view of Nimiya et al not resulting in the gasket being positioned over the end of the slit, the examiner takes the position that Nimiya et al teach the use of a gasket between and encircling the end plates and the associated sleeves (as discussed in column 7 line 60 through column 8 line 20) which when applied to Sasaki et al would result in the gasket being positioned over the end of the slit.

As concerns remarks pertaining to the combination of Sasaki et al in view of Nimiya et al being unreasonable, the examiner points out that the test for obviousness is what the combined teachings of the references would have fairly suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom (see *In re Preda*, 401 F.2d 825, 159 USPQ 342 (CCPA 1968)) and skill, rather than the converse, is presumed on the part of those of ordinary skill in the art (see *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985)). Also, as long as some motivation or suggestion to combine the

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references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor (see *In re Beattie*, 974 F.2d 1309, 24 USPQ 2d 1040 (Fed. Cir. 1992)). The fact that the applicants may have recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise have been obvious (see *Ex parte Obiaya*, 227 USPQ 58 (BPAI 1985), *aff'd* mem., 795 F.2d 1017 (Fed. Cir. 1986)). In the instant case, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the closure of Sasaki et al by incorporating an gasket including an adhesive between the end plates and the sleeves, as taught by Nimiya et al, in order to increase the sealing capabilities between the plates and the sleeves, and to provide a secondary sealing means between the plates and the sleeves in case the inherent sealing capabilities of the plate fail. The fact that the applicants have, for all intents and purposes, incorporated a gasket including an adhesive into a previously existing configuration, lends support to the position that it would have been proper to use the reference of Nimiya et al to teach the use of a gasket including an adhesive to the configuration of Sasaki et al.

As concerns remarks pertaining to the reference of Nimiya et al not teaching a third holding member along with other structural elements, the examiner points out that Nimiya et al are solely being relied upon for teaching the use of a gasket including an adhesive, discussed in column 7 lines 15-20 and illustrated in figures 6a, 6b, and 7, between end plates and members of a cable closure.

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*Conclusion*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce A. Lev whose telephone number is (703) 308-7470.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

bl

March 22, 1999



Daniel P. Stodola  
Supervisory Patent Examiner  
Group 3600